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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,431	11/13/2000	Marco M. Hurtado	SOM920000014US1	7725

23334 7590 08/25/2004

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EXAMINER

NOBAHAR, ABDULHAKIM

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/711,431

Applicant(s)

HURTADO ET AL.

Examiner

Abdulhakim Nobahar

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-11 and 13-18 is/are rejected.
- 7) ☒ Claim(s) 4 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 in line 4 and claim 10 in line 5 recite, "previously been associated" which does not indicate the association subject. Appropriate correction is required.

Claim 1 in line 4 and claim 10 in line 5 recite "wherein in the content is encrypted..." which is an unclear statement. Appropriate correction is required.

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Claim 1 in line 9, claim 4 in line 2, claim 6 in lines 9 and 16 and claim 10 in line 10 and claim 12 in line 3 recite "decrypting at least part of.... as permitted" which does not indicate the basis for "as permitted". Appropriate correction is required.

Claim 4 in line 3 and claim 12 in line 4, recites "reencrypting the decrypted content utilizes a..." which is an unclear statement. Appropriate correction is required.

Claim 6 in line 8, claim 14 in lines 8 and 15 and claim 18 in lines 9-10 and 16 recite the limitation "containing the decrypting key". There is insufficient antecedent basis for this limitation in the claims.

Claim 6 in line 10, claim 14 in lines 10 and 14 and claim 18 in line 11 recite the limitation "using the encrypting key". There is insufficient antecedent basis for this limitation in the claims.

Claim 6 in line 10 and claim 14 in line 10 recite, "creating an secure..." which is an unclear statement. Appropriate correction is required.

Claim 8 in line 1 and claim 16 in line 2, recites, "...establishing a secure connecting..." which is an unclear statement. Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 10-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 9-12 of U.S. Patent No. 6,611,812 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the application are a broader recitation of the patented claims. The claims in the examined application do not expressly specify that the metadata is associated with the encrypted content. Moreover, the claims in the examined application do not expressly specify that a controlling center such as a clearinghouse transfer the content decrypting key to an end-user system for decryption of the content by the end-user. The claims in the examined application are further rejected over the prior art as cited below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Rusnak et al. (6,098,056; hereinafter Rusnak).

Rusnak discloses a system and method for limiting access to digital content in stored an information network including at least one client and a server. Rusnak further discloses that a trusted information handler (TIH) is also included in the information network which uses cryptographic techniques in controlling access to the stored digital information (see col. 2, lines 59-67).

Claims 1 and 10

Rusnak discloses that a meta-information associated with the stored encrypted digital content is distributed to one or more users and a client program displays it on the

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client device (see col. 4, line 55-col. 5, line 10). The digital content is encrypted with a Document Encryption Key (DEK) (corresponding to the recited first key). Rusnak further discloses that the meta-information includes information about the digital content that user is interested to purchase (col. 4, lines 20-30). The system of Rusnak deploys a trusted information handler (TIH) for controlling access to the valuable digital information (col. 3, lines 8-17) and client(s) communicates with a Certificate Authority (CA) (corresponding to the recited authorization authority) in order to receive proper cryptographic keys for engaging in desired encryption and decryption operations (col. 5, lines 52-65). The connection among the client(s), the TIH and the server containing information in the Rusnak system are secured connections (col. 4, lines 2-10; col. 4, lines 31-36; col. 5, lines 27-32). Rusnak also discloses that the client or the user receives the decryption DEK from the server in order to decrypt the requested encrypted digital content (col. 5, lines 15-21).

#### Claim 2

Rusnak discloses that the client uses the DEK to decrypt the content to be processed for the intended purpose (corresponding to the recited playing at least part of the previously encrypted content) (col. 5, lines 23-27).

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Claim 3, 5, 11 and 13

Rusnak discloses that a tamper-resistant environment is provided for the process of encryption/decryption of the cryptographic key and the digital content (col. 5, lines 40-47).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-9 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rusnak et al. (6,098,056; hereinafter Rusnak) in view of Shear et al. (US 2001/00442043 A1; hereinafter Shear).

Claims 6, 14 and 18

This claim is rejected as applied to the like elements of claims 1 and 10 as stated above and further the following:

Rusnak discloses that the client program sends to a server the document encryption key (DEK) and other necessary information such as its own public key and a certificate for authentication to receive permission for decrypting the requested digital



content (col. 6, lines 8-35). Since a secure communication is established between the client and the server as stated above, thus the transmitted information between them containing the DEK is a secure container. Rusnak further discloses that after the authentication process is completed, the server sends a secure container to the client containing the re-encrypted decryption key (col. 6, lines 35-54).

Rusnak, however, does not expressly disclose the utilization of a clearinghouse for authentication purpose and obtaining permission to decrypt the requested digital content.

Shear discloses a cryptographic system for controlled usage of protected information stored on a media such as DVDs (see abstract, [0003] and [0031]). Shear further discloses that a third party such as a clearinghouse is used to authenticate and provide required permissions to client(s) for the usage of a digital content (see, for example [0064] and [0221]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate a clearinghouse entity as taught in Shear in the system of Rusnak, because it would provide support services and at least one additional set of control for the usage of protected information by clients [0221].

#### Claims 7 and 15

Shear discloses that each type of information has its own associated key (see, for example, [0078] and [0129]-[0132]). I.e., multiple keys are used to decrypt different information to provide further security for the digital content.

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Claims 8 and 16

Rusnak discloses that payment is received from a client before the content can be decrypted (col. 4, lines 1-10). This corresponds to receiving client's credit information in a secure connection by an authorization entity.

Claims 9 and 17

Shear discloses that metadata is stored with other information including unprotected information such as promotional data (see Fig. 3 and [0220]).

***Allowable Subject Matter***

Claims 4 and 12 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,646,992 to Subler et al.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdulhakim Nobahar whose telephone number is 703-305-8074. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

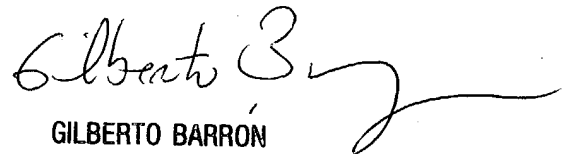
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Abdulhakim Nobahar  
Examiner  
Art Unit 2132

AN

August 16, 2004



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